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**DATE** December 2, 2004**SENDER ID #1215****FROM** Kathleen M. Williams**CLIENT #4231/2055****DIRECT DIAL #****NAME**Douglas I. Wood, Senior  
Petitions Attorney**COMPANY**United States Patent and  
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Atty. Docket No.: 4231/2055

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Choong-Chin Liew	Examiner:	Not Yet Assigned
Serial No.:	10/601,518		
Filed:	June 20, 2003	Group Art Unit:	1634
Titled:	Method for the Detection of Gene Transcripts in Blood and Uses Thereof	Conf. No.:	8219

**CERTIFICATE OF FACSIMILE TRANSMISSION**  
**UNDER 37 C.F.R. § 1.6d**

I hereby certify that this correspondence and any paper referred to as being enclosed are being facsimile transmitted on the date indicated below to the Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Attn. Office of Petitions, Fax No. (703) 872-9306.

Kathleen Williams

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Commissioner for Patents  
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**TRANSMITTAL LETTER**

Enclosed for filing the above-identified patent application, please find the following documents:

1. Petition to Accept Unintentionally Delayed Claim for Priority Under 35 U.S.C. 119(E);
2. Second Preliminary Amendment;
3. Copy of Decision on Petition (mailed September 22, 2004).

The Commissioner for Patents is hereby authorized to charge any fees to Deposit Account No. 16-0085, Reference 4231/2055. A duplicate of this transmittal letter is enclosed for this purpose.

Respectfully submitted,

Date:

12/2/04

Name: Kathleen M. Williams  
Registration No.: 34,380  
Customer No.: 29933  
Palmer & Dodge LLP  
111 Huntington Avenue  
Boston, MA 02199-7613  
Tel: 617-239-0100

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Atty. Docket No.: 4231/2055

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Choong-Chin Liew	Examiner: Not Yet Assigned
Serial No.: 10/601,518	
Filed: June 20, 2003	Group Art Unit: 1634
Titled: Method for the Detection of Gene Transcripts in Blood and Uses Thereof	Conf. No.: 8219

**CERTIFICATE OF FACSIMILE TRANSMISSION**  
**UNDER 37 C.F.R. § 1.64**

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Kathleen Williams

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PO Box 1450  
Alexandria, VA 22313-1450

**PETITION TO ACCEPT UNINTENTIONALLY DELAYED****CLAIM FOR PRIORITY UNDER 35 U.S.C. 119(E)**

This petition for acceptance of unintentionally delayed priority claim is being resubmitted with an amendment which does not include the phrase "incorporated by reference" as suggested in the dismissal letter dated September 22, 2004, a copy of which is attached. The dismissal was in response to a petition for acceptance of unintentionally delayed priority claim filed April 15, 2004.

Applicants respectfully petition for acceptance of unintentionally delayed priority claim.

Serial No. 10/601,518

At the time of filing, the application claimed priority as follows: This application is a continuation-in-part of Application No. 10/268,730 filed on October 9, 2002, which is a continuation of U.S. Application No. 09/477,148 filed January 4, 2000, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/115,125 filed on January 6, 1999.

In a preliminary amendment mailed on October 8, 2003, Applicants amended the specification to REPLACE the priority information listed above with the priority information listed below.

--This application is a continuation-in-part which claims priority under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 10/085,783, filed February 28, 2002, which claims priority under 35 U.S.C. § 119(e) to U. S. Provisional Application Serial No. 60/271,955, filed February 28, 2001, U. S. Provisional Application Serial No. 60/275,017, filed March 12, 2001, and U. S. Provisional Application Serial No. 60/305,340, filed July 13, 2001.--

However Applicants meant to claim priority to BOTH A) the set of applications listed with the original specification, AND B) the set of applications added October 8, 2003. By filing this petition, Applicants request that the original priority information which was unintentionally deleted on October 8, 2003, be again added to the specification according to the attached supplemental preliminary amendment.

Accordingly, Applicants hereby respectfully request that the original claim for priority, which is as follows; This application is a continuation-in-part of Application No. 10/268,730 filed on October 9, 2002, which is a continuation of U.S. Application No. 09/477,148 filed January 4, 2000, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/115,125 filed on January 6, 199, be ADDED to the priority applications listed in the preliminary amendment of 10/8/2003 in the present application. Applicants hereby state that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional.

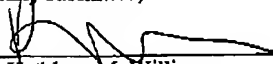
Serial No. 10/601,518

Please charge the \$1,330.00 surcharge under 37 C.F.R. §1.17(t), as well as any additional fees required in connection with the papers transmitted herewith to Deposit Account No. 16-0085, Reference No. 4231/2055.

Date:

12/2/04

Respectfully submitted,



Name: Kathleen M. Williams  
Registration No.: 34,380  
Customer No.: 29933  
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Docketed 10/22/04  
Response Due 10/22/04  
Submitted 10/22/04  
Patent & Dodge LLP  
Patent Department

PALMER & DODGE, LLP  
KATHLEEN M. WILLIAMS  
111 HUNTINGTON AVENUE  
BOSTON MA 02199

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OFFICE OF PETITIONS

In re Application of  
Choong-Chin Liew  
Application No. 10/601,518  
Filed: 20 June, 2003  
Atty Docket No. 4231/2055,

:  
: DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(3)  
: AND  
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition filed on 15 April, 2004, which is treated as a petition filed under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional applications set forth in the amendment filed on 15 April, 2004.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after 29 November, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119 and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;<sup>1</sup>

<sup>1</sup>Any nonprovisional application or international application designated the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designated the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and indicating the

Application No. 10/601,518

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(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

A reference to add the prior-filed applications on page one following the first sentence of the specification has been included in an amendment filed on 15 April, 2004. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior applications. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980) where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re de Seversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to piece new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

Accordingly, before the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and a substitute amendment to correct the above matters is required.

In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile to the number indicated below and to the attention of Senior Petitions Attorney Douglas I. Wood.

relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

Application No. 10/601,518

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Further correspondence with respect to this matter should be addressed as follows:

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Commissioner for Patents  
P.O. Box 1450  
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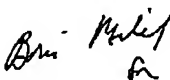
By FAX: (703)872-9306  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
220 20<sup>th</sup> Street S.  
Customer Window, Mail Stop Petitions  
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Arlington, VA 22202

In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile to the number indicated below and to the attention of Senior Petitions Attorney Douglas I. Wood.

The application is being forwarded to Technology Center 1600 for examination in due course.

Telephone inquiries should be directed to Senior Petitions Attorney Douglas I. Wood at 703-308-6918.

  
Charles A. Pearson  
Director, Office of Petitions



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